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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/344,111 06/24/99 ONO

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

EXAMINER

HOOSAIN, A

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/344,111	ONO, YASUMASA	
	Examiner	Art Unit	
	Allan Hoosain	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 1999.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |  |  |
|--|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____    | 20) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 6/23/99 and 6/24/1998. It is noted, however, that applicant has not filed certified copies of the foreign applications as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 5, 11-12, 15 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rao (US 5,896,165).

As to Claim 1, with respect to Figures 1-3, Rao teaches a communication apparatus capable of receiving communication information from the outside, comprising:

Call pick up (discrimination means) for discriminating presence or absence of reception of the communication information (Figure 2, label 32); and

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Control codes (control means) for executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, label 36, 60, 62).

As to Claims 2,12, **Rao** teaches a communication apparatus according to claim 1, wherein said discrimination means has a function of:

discriminating whether the communication information is an image signal, and said control means executes control, in case the communication information is judged as the image signal, to cause said recording apparatus to start recording (Figure 2, label 60).

As to Claims 5,15, **Rao** teaches a communication apparatus according to claim 1, wherein said recording apparatus includes transmission means for transmitting said communication information, and said control means executes control, through said transmission means, to set said recording apparatus in a state capable of recording (Figure 1, labels 78,79,80).

As to Claim 11, with respect to Figures 1-3, **Rao** teaches a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising:

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 2, labels 30-32); and

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a control step of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, labels 36,60,62).

As to Claim 21, with respect to Figures 1-3, **Rao** teaches a computer readable memory medium storing a program for executing a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 1 and Figure 2, labels 30-32); and

a control step of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, labels 36, 60, 62).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4 and <sup>13</sup>4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rao** in view of **Skarbo et al.** (US 5,778,053).

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As to Claims 3,13, **Rao** teaches a communication apparatus according to claim 1, wherein said control means executes control, in case the communication information is judged as the image signal, to cause said recording apparatus to start recording (Col. 3, lines 1-7).

**Rao** does not teach the following limitation:

“and to record the recording start point at the start of recording”

**Skarbo** teaches the limitation (Col. 8, lines 4-34). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add start time capability to **Rao**'s invention for playing back recordings as taught by **Skarbo**'s invention in order to provide tracking and status information.

As to Claims 4,14, **Rao** teaches a communication apparatus according to claim 3, wherein said control means executes control, in case the communication information is judged as the image signal, to cause said recording apparatus to start recording (Figure 2, labels 50 and 52).

**Rao** does not teach the following limitation:

“and to record identification information for recognizing the recording start point at the start of recording”

**Skarbo** teaches the limitation (Col. 8, lines 4-34). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add start time capability to **Rao**'s invention for playing back recordings as taught by **Skarbo**'s invention in order to provide tracking and status information.

6. Claims 6-10 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rao** in view of **Gerszberg et al.** (US 6,052,439).

As to Claims 6,16, **Rao** teaches a communication apparatus according to claim 5:

**Rao** does not teach the following limitation:

“wherein said transmission means transmits said communication information according to the IEEE 1394 based interface standard”

**Gerszberg** teaches the limitation (Col. 5, lines 1-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add IEEE 1394 capability to **Rao**'s invention for providing networking as taught by **Gerszber**'s invention in order to provide desirable network interfaces.

As to claims 7,17, **Rao** teaches a communication apparatus according to claim 6, wherein said communication apparatus is applicable to a message telephone (Figure 1, labels 62,64).

As to claims 8-9,18-19, **Rao** teaches a communication apparatus according to claim 1.

**Rao** does not teach the following limitation:

“wherein said recording apparatus is a magnetic recording apparatus”

**Gerszberg** teaches the limitation (Col. 8, lines 7-17). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add magnetic storage capability to **Rao**'s invention for providing storage as taught by **Gerszber**'s invention in order to provide appropriate storage of information.

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As to Claims 10,20, Rao teaches a communication apparatus according to claim 8, wherein said recording apparatus is a hard disk device (Col. 1, lines 62-66).

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yuen et al. (US 5,488,409) teach a VCR with programmed start and stop times.

Hashimoto (US 5,046,079) teach a telephone answering device with a TV telephone.

Yuen et al. (US 5,970,206) teach programming a VCR using codes and calendars.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6296 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
Allan Hoosain  
Primary Examiner  
06/03/01